



1 fm AZ

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS**

Assignee's Docket No.: 9457.00)
Group Art Unit: 3692)
Serial No.: 10/051,355)
Examiner: Siegfried Chencinski)
Filing Date: January 18, 2002)
Title: Self-Service Terminal)

)

CERTIFICATE OF MAILING

I certify that this document is addressed to Mail Stop AF, Commissioner of Patents, PO Box 1450, Alexandria, VA 22313-1450, and will be deposited with the U.S. Postal Service, first class postage prepaid, on February 11, 2008.



Gregory A. Welte

APPEAL BRIEF

A Summary of Argument Begins on Page 10

The fee for this Brief may be billed to Deposit Account 14 - 0225, NCR Corporation.

1. REAL PARTY IN INTEREST

NCR Corporation.

2. RELATED APPEALS AND INTERFERENCES

None.

3. STATUS OF CLAIMS

Claims 1 - 20 are pending, rejected, and appealed.

10/051,355
Art Unit 3692
9457.00

4. STATUS OF AMENDMENTS

No Amendment-After-Final has been submitted.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Summary in Brief

Two people are involved in a transaction with an ATM, Automated Teller Machine. One party, a courier, visits the ATM, and the other party, an account holder, remains at home.

The courier initiates a log-in procedure at the ATM. The ATM then places a telephone call to the account holder (who is at-home). The account holder then enters identifying data, such as a PIN, and requests a cash withdrawal, all via telephone. The ATM dispenses cash to the courier.

This allows an account holder who is confined to a wheelchair, for example, to withdraw cash in a safe manner from an ATM, while remaining at home. If, instead, the account holder merely handed his ATM card to the courier, together with the PIN, the courier could raid the ATM account.

Summary in Detail

An ATM account holder gives a courier an ATM card which allows the courier to initiate a transaction at ATM 14a in Figure 2. (Specification, page 2, lines 11 - 12; Specification, page 3, lines 9 - 14.) The ATM looks up a telephone number associated

10/051,355
Art Unit 3692
9457.00

with the account holder, and contacts the account holder, by making a telephone call. (Specification, page 2, lines 13, 14.)

It is significant that, in one embodiment, the ATM calls the account holder. The reverse does not occur: neither the account holder, nor the courier, calls the ATM. (Specification, page 2, lines 24 - 28.) Thus, neither the account holder, nor the courier, need be equipped with knowledge of any telephone numbers.

The account holder (not the courier, who is located at the ATM) then enters a PIN, together with a request for a cash amount to be dispensed, via telephone. (Specification, page 2, lines 14, 15.) The courier collects the dispensed cash at the ATM. (Specification, page 2, lines 16 - 18; cash is dispensed by CASH DISPENSER 58 in Figure 3.)

Alternately, the account holder can be located at the ATM, and the ATM calls a cell phone which is in the possession of the account holder, and is thus located at the ATM. (Specification, page 2, lines 19 - 21; page 3, lines 3, 4.)

The ATM can obtain the telephone number from the ATM card presented to it, or from a database once the account holder is identified, based on the ATM card. (Specification, page 3, lines 19 - 23.)

10/051,355
Art Unit 3692
9457.00

Mapping of Claim Elements in Independent Claims

Parenthetical phrases, in **bold typeface**, are inserted into the following independent claims, to identify matter in the Specification and Figures which supports the claim language adjacent said **bold, parenthetical typeface**.

1. An Automated Teller Machine, ATM, (**ATM 14a, Figure 2**) comprising:

- a) a user interface including means for identifying a user (**Interface 22, Figure 2; Specification, page 8, lines 12 - 24**);
- b) means for obtaining contact information which enables the ATM to contact a communications device associated with the user (**Specification, page 8, lines 21 - 24; application 82, Figure 3**); and
- c) contact means for establishing a link with the communications device to allow a transaction to be executed using the communications device (**Specification, page 8, line 21 - page 9, line 13; application 82, Figure 3**).

5. An Automated Teller Machine, ATM, (**ATM 14a, Figure 2**)

10/051,355
Art Unit 3692
9457.00

comprising:

- a) a user interface including means for identifying a user (**Interface 22, Figure 2; Specification, page 8, lines 12 - 24**);
- b) means for obtaining telephone number for a telephone associated with the user (**Specification, page 8, lines 21 - 24**); and
- c) contact means for establishing a link with the telephone to allow a transaction to be executed using the telephone (**Specification, page 8, lines 21 - 24**).

6. An automated teller machine (ATM) (**ATM 14a, Figure 2**) comprising:

- a) a cash dispenser for dispensing cash (**dispenser 58, Figure 3**);
- b) means for obtaining contact information which enables the ATM to contact a communications device associated with an ATM customer (**Specification, page 8, lines 21 - 24; application 82, Figure 3**);
- c) means for establishing a link with the communications device based upon the obtained contact information to allow the ATM customer

10/051,355
Art Unit 3692
9457.00

to enter an ATM transaction (**Specification, page 8, lines 21 - 24; Interface 17, Figure 1**) ; and

d) means for controlling the cash dispenser to dispense cash when the entered ATM transaction requires cash to be dispensed (**Specification, page 8, line 21 - page 9, line 13; application 82, Figure 3**).

10. An automated teller machine (ATM) (**ATM 14a, Figure 2**) comprising:

a cash dispenser for dispensing cash (**dispenser 58, Figure 3**);

means for obtaining a telephone number for a telephone associated with an ATM customer

(**Specification, page 8, lines 21 - 24; application 82, Figure 3**);
means for establishing a link with the telephone based upon the obtained telephone number to allow the ATM customer to enter an ATM transaction (**Specification, page 8, lines 21 - 24**) ; and
means for controlling the cash dispenser to dispense cash when the entered ATM

10/051,355
Art Unit 3692
9457.00

transaction requires cash to be dispensed
**(Specification, page 8, line 21 - page 9,
line 13; application 82, Figure 3).**

11. A system of Automated Teller Machines, ATMs, comprising
(ATMs 14, Figure 1):

- a) a host (**Host 12, Figure 1**);
- b) a group of ATMs (**ATMs 14, Figure 1**), each having a user interface (**interface 22, Figure 2; Specification, page 6, lines 20 - 23**) including transaction entry means and means for identifying a user (**keypad 28, Figure 3**);
- c) means for obtaining contact information which enables an ATM to contact a communications device associated with the identified user (**Specification, page 8, lines 17 - 26**); and
- d) contact means for contacting the communications device to allow a transaction to be executed using the communications device (**Specification, page 8, line 24 - page 10, line 6**).

10/051,355
Art Unit 3692
9457.00

12. A method of operating an Automated Teller Machine, ATM,
(ATM 14a, Figure 2) the method comprising the steps of:

- (a) identifying a user (**Specification, page 8, lines 12 - 17**);
- (b) obtaining contact information which enables the ATM to contact a communications device associated with the identified user (**Specification, page 8, lines 17 - 26**); and
- (c) establishing a telecommunications link with the communications device so that a transaction may be executed via the link (**Specification, page 8, line 24 - page 10, line 6**).

16. A method of operating an automated teller machine (ATM)
(ATM 14a, Figure 2), the method comprising the steps of:

- (a) identifying an ATM customer desiring to carry out an ATM transaction (**Specification, page 8, lines 12 - 17**);
- (b) obtaining contact information which enables the ATM to contact a communications device associated with the identified ATM customer (**Specification, page 8, lines 17 - 26**); and

10/051,355
Art Unit 3692
9457.00

(c) establishing a link with the communications device associated with the ATM customer to allow the ATM customer to enter the desired transaction (**Specification, page 8, line 24 - page 10, line 6**).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The rejection of claim 12 under 35 USC § 112, on the grounds that the scope of claim 12 is not co-extensive with an embodiment set forth in another part of the Specification.

The rejection of claims 1, 3 - 6, 8 - 12, 14 - 16, 18, and 19 as obvious under 35 USC § 103, based on Ahuja and Savage.

The rejection of claims 2 and 13 as obvious under 35 USC § 103, based on Ahuja, Savage, and Official Notice.

The rejection of claim 7 as obvious under 35 USC § 103, based on Ahuja, Savage, and Official Notice.

The rejection of claims 17 and 20 as obvious under 35 USC § 103, based on Ahuja, Savage, and Walker.

10/051,355
Art Unit 3692
9457.00

7. ARGUMENT

SUMMARY OF ARGUMENT

Point 1 Claim Elements Missing from References, Even if Combined

All claims recite the following, or similar:

- 1) an apparatus in an ATM which
- 2) contacts a telephone or other device associated with an account holder, to thereby
- 3) allow the account holder to execute a transaction via the telephone/device.

For example, claim 5 recites, within an ATM,

-- means which can contact a telephone, to allow the telephone to execute a transaction.

As another example, claim 1 recites, within an ATM,

- 1) a "communication device" ("CD" herein) "associated with a user" and
- 2) means, in the ATM, for establishing a "link" with the CD, to allow the CD to execute a transaction.

The Final Office Action cites Savage, column 4, lines 15 - 18, to show these recitations.

Savage does not show the recitations.

Savage in general discusses an ATM at which customers can execute transactions using the spoken word, via a microphone and

10/051,355
Art Unit 3692
9457.00

loudspeaker, instead of pressing buttons. At the cited location, Savage states:

Other users may choose other voices, or the voice may be selected by the ATM operator.

A user whose account is overdrawn may be advised, in a stern male voice, to immediately contact the relevant financial institution.

(Savage, column 4, lines 15 - 18.)

Plainly, this fails to show the claim recitations in question, namely,

- 1) an ATM contacting a telephone, or communication device, and
- 2) the use of that telephone/device to execute a transaction.

MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

The recitations in question are not found in the references.

Point 2
Office Action Ignores Claim Recitations

The Final Office Action ignores claim language. On page 5, lines 10 - 12, it states:

10/051,355
Art Unit 3692
9457.00

The phrases "which enables the ATM to contact a communications device associated"

and

"so that a transaction may be executed via the link"

are non-functional descriptive information and therefore carry no patentable weight.

This type of comment is repeated on page 6, lines 10 - 12, and in other rejections.

Claim recitations cannot be ignored.

MPEP § 2143.03 states: "All words in a claim must be considered in judging . . . patentability."

MPEP § 2173.01 states that a claim may use "any style of expression."

MPEP § 2173.05(g) states that "functional language" is acceptable because it defines a capability of an element:

A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.

Ergo, any type of language which defines a capability of an element is acceptable.

The language which the Office Action eliminates is not found in the references. Thus, when the eliminated language is

10/051,355
Art Unit 3692
9457.00

restored, the references do not show the claims.

Point 3
No Teaching Given For Combining References

For most claims, the rationale given for combining the references is that the combination "facilitate[s] communication with a user." (E.g., page 5, end of fourth-to-last paragraph.) However, this rationale suffers several problems.

Problem 1

This rationale is a verbatim quote from Savage. (Column 1, lines 7, 8.) This quote sets forth a supposed characteristic of Savage.

A characteristic of a reference is not a teaching that the reference should be combined with another patent. That is a matter of simple logic.

Problem 2

This rationale sets forth a goal which the Office Action asserts the combination of references achieves. However, Savage, by himself, states that he achieves this goal.

Thus, there is no reason to combine the references to achieve the goal (which is "facilitat[ing] communication with the user.") Consequently, the stated goal does not act as a motivation to combine the references. One reference, alone,

10/051,355
Art Unit 3692
9457.00

achieves the goal.

Problem 3

Even if the combination of references achieves this goal (which has not been shown, as explained below), this goal is merely a **characteristic** of the combined references.

A characteristic of combined references is not a teaching for combining the references in the first place. Otherwise, every combination of references would be obvious, because every combination has some characteristics or other.

Problem 4

Savage "facilitates communication with a user" by providing a speech interface at an ATM. That is, a customer can speak to, and listen to, the ATM, rather than press buttons of the ATM.

But the claims do not recite that. The Office Action has not shown how Savage's talking/listening ATM, when combined with Ahuja, shows an ATM which dials a telephone number, and executes a transaction over the telephone.

The Office Action's rationale leads to **something other** than Appellant's claims, namely, a combination of Savage with Ahuja. That combination does not contain the telephone, or "communications device," as claimed.

10/051,355
Art Unit 3692
9457.00

Problem 5

This specific rationale (the combination of references "facilitates communication") is part of a larger rationale which is based on hindsight.

The MPEP states that some hindsight is allowed. However, the hindsight cannot be based on Appellant's own disclosure. The hindsight-reasoning must be found in the prior art.

In this case, the bulk of the reasoning for rejecting the claims is found in Appellant's patent application. Specifically, the rejection takes a three-part approach:

- 1) The rejection sets forth the standard boilerplate conclusion, namely, that the invention is obvious to the person skilled etc.
- 2) The rejection gives a summary of the claimed invention.
- 3) The rejection then asserts that the invention, as summarized, is obvious (as in (1) above), because the combination of references "facilitates communication" (which is a quote from Savage).

This approach involves impermissible hindsight because, in essence, it does nothing more than

- 1) outline the claimed invention, and

10/051,355
Art Unit 3692
9457.00

2) assert that the invention is obvious because of a five-word phrase in Savage.

That is hindsight. Essentially nothing in this rationale is found in the prior art, as required by the MPEP.

Point 4

Claims 5 and 10 recite obtaining a telephone number. Those claims were rejected, based on Savage and Ahuja.

The Office Action, in rejecting claims 2 and 13 (page 8, lines 10 and 11), admits that Savage and Ahuja **do not show obtaining a telephone number.**

Thus, the rejection of claims 5 and 10 cannot stand. The Office Action contradicts itself.

Comment

Not all points discussed in this Summary are outlined below. Some are considered self-explanatory.

END SUMMARY

ARGUMENT

ARGUMENT re: REJECTION OF CLAIM 12 UNDER 35 USC § 112

The rejection asserts that Appellant failed to set forth (in claim 12) the subject matter which applicant regards as the

10/051,355
Art Unit 3692
9457.00

invention.

Point 1

This assertion requires evidence which shows

- 1) Appellant's subjective intent as to what he regards as the invention and
- 2) Failure of claim 12 to comport with that intent.

No such evidence of (1) has been provided in the Office Action.

Point 2

MPEP § 2172(I), when read with § 2171, states that

- Applicant must have stated, **other than in the application as filed**, that the actual invention is different from what is defined in the claims, and
- Absent such evidence, the invention set forth in the claims is **presumed** to be that which Applicant regards as the invention.

No evidence, as required by this MPEP section, has been provided.

The Office Action has not overcome the presumption created by this MPEP section.

10/051,355
Art Unit 3692
9457.00

Point 3

The Office Action's position is **directly contrary** to the MPEP. MPEP § 2172(II) states:

...
The content of applicant's specification is not used as evidence that the scope of the claims is inconsistent with the subject matter which applicants regard as their invention.

(Citation.)

Point 4

Under section 112, the claims are **part of the Specification**. Section 112 states, in part:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is part of the original Specification.

Therefore, by Appellant's submission of claim 12, in the original Specification, Appellant indicated that claim 12 represents subject matter which Appellant regards as his invention.

This directly contradicts the Office Action's assertion, and the Office Action has provided no contrary evidence.

10/051,355
Art Unit 3692
9457.00

Point 5

The Office Action, in essence, is asserting that part of the Detailed Description is different from claim 12. Thus, the Office Action concludes that claim 12 is not regarded by Appellant as his invention.

Appellant points out that this argument is illogical. This argument fails to recognize that it is axiomatic that a Specification can contain different embodiments.

The mere presence of different embodiments does not mean that every claim must correspond to every embodiment..

Point 6

The Office Action, pages 2 - 4, quotes a section of the Specification (Appellant has not checked that; Appellant assumes the quotation to be accurate).

Then the Office Action, page 4, concludes that claim 12 is defective because it fails to correspond to the quoted section.

Appellant requests a citation of authority in support of this assertion. One reason is that claim 12 can be supported by **another** section of the Specification, and can be supported by itself, since claim 12 is **part of the original Specification**.

Point 7

The Office Action, page 5, refers to "one full embodiment,"

10/051,355
Art Unit 3692
9457.00

and asserts that claim 12 must "embody" at least "one full embodiment."

Appellant points out that this assertion is erroneous.

The Office Action confuses a claim with an embodiment.

The claims are not required to correspond to an "embodiment" selected by the PTO.

ARGUMENT re:

**REJECTION OF CLAIMS 1, 3 - 6, 8 - 12, 14 - 16, 18, AND 19
AS OBVIOUS UNDER 35 USC § 103, BASED ON AHUJA AND SAVAGE**

Claim 1

Claim 1 recites:

1. An Automated Teller Machine, ATM, comprising:
 - a) a user interface including means for identifying a user;
 - b) means for obtaining contact information which enables the ATM to contact a communications device associated with the user; and
 - c) contact means for establishing a link with the communications device to allow a transaction to be executed using the communications device.

**Point 1 - Even if References are Combined,
Claim Elements are Missing**

Claim 1(b) recites a "communications device associated with the user." The Specification, page 8, line 27, provides an example of this "device," namely, "cellular telephone 21."

10/051,355
Art Unit 3692
9457.00

This claimed "communications device" has not been shown in the references, even if combined. The Office Action relies on two passages in Ahuja to show this, namely,

- 1) paragraph 38, lines 4 - 6, and
- 2) paragraph 17, lines 4 - 6.

(Office Action, page 5, lines 4, 5.)

However, passage (1) has no relevance whatever to the claimed "communications device." Passage (1) merely refers to ATMs in Ahuja's prior art, which require hard-wired telephone lines in order to function. That does not show the claimed "communications device associated with the user."

Passage (2) also fails to show this claim recitation. Passage (2) merely summarizes one aspect of Ahuja's invention, which involves portable ATMs, which need no hard-wired telephone lines. They use wireless communication for the portable terminals.

The only "communications device" possible in passage (2) is the portable ATM itself. However, that does not show the claimed "communications device associated with the user."

Further, claim 1 states that the "ATM" "contacts" the "communications device." Under the Office Action's reading of Savage, the ATM in Savage "contacts" itself. That makes no sense.

Therefore, the claimed "communications device" is not found

10/051,355
Art Unit 3692
9457.00

in the combination of references. MPEP § 2143.03 states:

To establish prima facie obviousness . . .
all the claim limitations must be taught or suggested by the prior art.

Point 2 - Even if References are Combined,
Claim Elements are Missing

Claim 1(c) states that a "link" is established with the claimed "communications device" "to allow a transaction to be executed using the communications device."

No such link is found in the references.

The Office Action cites passages (1) and (2), above, to show this "link." However, it is self-evident in the discussion above that the claimed "link" is not found in those passages.

Point 3 - Even if References are Combined,
Claim Elements are Missing

As Point 2, above, explained, a "transaction" is "executed using the communications device."

Passages (1) and (2) of Ahuja show no such "transaction," nor such a "communications device."

Point 4 - No Teaching Given for Combining References
Part 1

Ahuja shows portable ATMs, which use wireless communication to verify transactions. He does this to reduce the cost of hard-wiring telephone lines to ATMs. (Paragraphs 17, 38, 41.)

10/051,355
Art Unit 3692
9457.00

Savage shows an ATM in which a user can execute a transaction verbally, without punching any keys and without reading a display. (Summary of Invention.)

Appellant points out that nothing is present in the references which suggests claim 1. For example,

- Where is the claimed "communications device associated with the user" ?
- Where is the claimed "obtaining contact information which enables the ATM to contact" the claimed "communications device" ?
- Where is the claimed "transaction" which is executed through that "contact" (or "link") ?

These three elements are not present.

Since these elements are not present, Appellant submits that it is axiomatic that no teaching can be present suggesting the combination of the (absent) elements.

Point 5 - No Teaching Given for Combining References
Part 2

The rationale given by the Office Action for combining the references is that the combination of references is motivated by "a desire to facilitate communication with a user." (Office Action, page 6, line 13 et seq.)

10/051,355
Art Unit 3692
9457.00

However, several problems exist in this rationale.

PROBLEM 1

The rationale is a verbatim quote from Savage. (Column 1, lines 7, 8.) That quote sets forth a characteristic of the Savage reference.

Appellant points out that a characteristic of a reference, set forth in the reference, does not act as a teaching in favor of combining that reference with another reference.

That is a simple matter of logic.

PROBLEM 2

The PTO asserts that its rationale provides a motivation, or goal, for combining the references.

The rationale, again, is a quote from Savage.

That quote points to something that Savage supposedly achieves (facilitation of communication with users).

Thus, if you wish to attain that goal (facilitation of communication), you can merely follow Savage's teaching, and use his invention.

There is no reason to combine Savage with the other reference, to attain that goal. Savage, by himself, states that he attains the goal.

Thus, the stated goal does not lead to a combination of the

10/051,355
Art Unit 3692
9457.00

references, because the combination is not needed to attain the goal. The Savage reference itself says that.

PROBLEM 3

The rationale is based on hindsight.

MPEP § 2145.(X) (A) states:

A. Impermissible Hindsight

Applicants may argue that the examiner's conclusion of obviousness is based on improper hindsight reasoning.

However, "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account **only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure**, such a reconstruction is proper." [Citation.]

The Office Action's rationale for combining the references is found on page 6, lines 13 - 18:

Therefore, an ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to have used the disclosures of Ahujah combined with those of Savage in order to establish

a method, system, and an apparatus for operating an Automated Teller Machine, ATM, which includes establishing a telecommunications link with the communications device so that a transaction may be executed via the link

10/051,355
Art Unit 3692
9457.00

motivated by a desire to facilitate communication with a user.

Appellant breaks this rationale into three parts.

The first part ("Therefore . . . to establish") is the conclusion of the rationale.

The second part ("a method . . . via the link") together with the third part ("motivated . . . with a user") form the rationale. The rationale is supposed to lead to the conclusion.

However, the second part is merely a paraphrase of claim 1. Nothing in that second part is found in the references.

The third part, as explained above, is taken from Savage, column 1, lines 7, 8.

Therefore, this rationale violates the MPEP section cited above. The rationale, in essence, does nothing more than

- 1) outline the claimed invention, and
- 2) assert that the invention is obvious because of a five-word phrase in Savage.

Where is the "reconstruction . . . [which] takes into account only knowledge which was within the level of ordinary skill in the art" as required by this MPEP section ?

There is none.

The rejection is based on hindsight.

10/051,355
Art Unit 3692
9457.00

PROBLEM 4

There is no connection between the PTO's rationale and the claim.

The second part of the rationale is repeated here:

[The combined references show]

a method, system, and an apparatus for operating an Automated Teller Machine, ATM, which includes establishing a telecommunications link with the **communications device** so that a transaction may be executed via the link

The Office Action asserts that the **highlighted** "communications device" corresponds to Savage's ATM machine, which communicates with a customer.

However, as explained above, that "communications device" (Savage's talking/listening ATM) does not correspond to the claimed "communications device."

One reason is that, under the claim, "contact data" is obtained, which allows an ATM to establish a "link" with the "communications device." Neither the claimed "contact data" nor the claimed "link," nor the claimed establishment of that "link" by the ATM is found in Savage.

In Savage, a server contacts an ATM (the supposed "communications device"). That does not correspond to the claim.

Another reason is that the "communications device" is

10/051,355
Art Unit 3692
9457.00

"associated with the user."

It could be (incorrectly) argued that the ATM of Savage is "associated with the user," because the user is nearby. However, that would make no sense, given other claim language. Other claim language states that the ATM "contacts the communications device." Under the (incorrect) argument, the ATM contacts itself, which makes no sense.

Therefore, the two references, as combined by the Office Action, do not show the claim. Again, the "communications device," which the Office Action interprets to be Savage's ATM, does not correspond to the claimed "communications device."

There is no connection between the PTO's rationale and the claim. Thus, the rationale does not lead to the claimed invention. It proposes **something else**, namely, a combination of a talking/listening ATM, as in Savage, with a portable ATM which communicates with the ATM network wirelessly, as in Ahuja.

PROBLEM 5

No expectation of success has been shown. The Office Action finds the claimed "communications device" in **two** elements in the references.

-- The Office Action, page 5, lines 4, 5, asserts that the claimed "communications device" is shown in Ahuja's portable ATM.

10/051,355
Art Unit 3692
9457.00

-- The Office Action, page 5, end of fourth-from-last paragraph, asserts that the ATM in Savage qualifies as the claimed "communications device."

Thus, the Office Action finds the claimed "communications device" in **two** elements in the references.

The Office Action is combining two ATMs.

What is produced when the two ATMs are combined ? The Office Action does not explain this.

MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . .
To establish a prima facie case of obviousness, three basic criteria must be met.

. . .
Second, there must be a reasonable expectation of success.

. . .
The . . . reasonable expectation of success must . . . be found in the prior art and not based on applicant's disclosure.

The Office Action has not explained how combining two ATMs produces the claimed invention.

Point 6 - Elimination of Claim Language not Allowed

10/051,355
Art Unit 3692
9457.00

The Office Action, page 6, lines 10 - 12, eliminates certain claim phrases, on the grounds that the phrases "are non-functional descriptive information." This elimination is not allowed, for several reasons.

REASON 1

MPEP § 2143.03 states:

All words in a claim must be considered in judging the patentability of that claim against the prior art. [Citation.]

REASON 2

Summary: eliminating the claim phrase eliminates a definition of a claim term, which renders the claim term meaningless (when read in isolation).

According to the PTO, the phrases "**describe**" claim elements. If a phrase "describes" something, as the Office Action asserts, then the phrase **sets out characteristics** of that thing. The phrase is **part of a definition**.

Definitions in a claim cannot be ignored.

For example, one eliminated claim phrase is "which enables the ATM to contact a communications device associated . . .".

The overall claim phrase is this:

10/051,355
Art Unit 3692
9457.00

means for obtaining **contact information** which enables the ATM to contact a communications device associated with the user

The (eliminated) phrase **defines** the "contact information."

If the phrase is eliminated, then the term "contact information" becomes isolated.

- Does it refer to electrical contacts ?
- Does it refer to contact lenses ?
- Does it refer to tactile information, which is obtained by "contact" (as in Braille writing) ?

The Office Action is eliminating claim terminology, and the elimination renders a claim term uncertain, or at least requiring explanation.

That is not allowed.

REASON 3

The elimination of the claim phrase is ineffective.

As explained above, the elimination of the phrase leaves the term "contact information" by itself. Thus, the question arises, "What does 'contact information' mean ?"

The Specification, page 1, lines 20 et seq., explains that "contact information" allows the self-service terminal to contact a communications device associated with the user, to execute a

10/051,355
Art Unit 3692
9457.00

transaction, via a "link." The Specification, page 3, line 3 et seq., explains that the "communications device" can be a telephone or cell phone.

Thus, elimination of the claim phrase is ineffective. The elimination raises the question of what a remaining claim term ("contact information") means. That question is answered by resort to the Specification. The answer, in effect, restores the eliminated claim language.

MPEP § 2106(II)(C) states:

Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim.

MPEP § 2111 states:

PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions OR OTHERWISE that may be afforded by the written description contained in applicant's specification.

MPEP § 2173.05(a) states:

During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification.

10/051,355
Art Unit 3692
9457.00

MPEP § 2173.05(n) states:

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms may be ascertained by reference to the description.

REASON 4

The Office Action asserts that the claim phrase carries "no patentable weight," and so it elimination the phrase. As just explained, that elimination requires the term "contact information" be explained.

Consequently, the claim, as interpreted by the PTO, seems to be indefinite.

In such a case, a specific rule applies, namely, MPEP § 2143.03, which states:

INDEFINITE LIMITATIONS MUST BE CONSIDERED

A claim limitation which is considered indefinite cannot be disregarded.

If a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should

reject the claim as indefinite under 35 USC 112 . . .

and

10/051,355
Art Unit 3692
9457.00

should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable.
[Citation.]

The Office Action fails to follow this two-step procedure.

This procedure is invoked by the fact that the Office Action interprets the claim in a manner which renders it indefinite, as explained above. (Ie, what does "contact information" mean, without the eliminated defining phrase?)

The required procedure is

- 1) the claim must be rejected as indefinite and
- 2) an interpretation must be selected "that renders the prior art applicable," and the claim then rejected.

That has not been done.

REASON 5

MPEP § 2173.01 states:

Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. (Citation.)

This MPEP section precludes elimination of the claim

10/051,355
Art Unit 3692
9457.00

language.

CONCLUSION AS TO ELIMINATION OF LANGUAGE

The Office Action has cited no authority in support of its elimination of claim language.

The MPEP sections cited above state that the claim language cannot be ignored.

Conclusion as to Claim 1

Appellant submits that the preceding discussion indicates that the rejections of claim 1 cannot stand.

Claims 11 and 12

The discussion of claim 1 applies to claims 11 and 12.

Claims 3, 8, 14, and 18

The rejection relies on paragraphs 46 and 47 in Ahuja. The rejection asserts that wireless communication between a server in Ahuja and a portable ATM shows claims 3 and 4.

However, nowhere has the Office Action shown an ATM which "contacts the communications device directly," when said "device" is "associated with the user."

Under the parent claim, the "communications device associated with the user" is reached through "contact

10/051,355
Art Unit 3692
9457.00

information" which is obtained by the ATM. That is not found in the references.

This applies to claims 8, 14, and 18.

Claims 4, 9, 15, and 19

The rejection relies on paragraphs 46 and 47 in Ahuja. The rejection asserts that wireless communication between a server in Ahuja and a portable ATM shows claims 3 and 4.

However, nowhere has the Office Action shown an ATM which requests a remote transceiver to contact the "communications device" when said "device" is "associated with the user."

Under the parent claim, the "communications device associated with the user" is reached through "contact information" which is obtained by the ATM. That is not found in the references.

This applies to claims 9, 15, and 19.

Claims 5 and 6

The discussion above applies here.

In addition, the following points apply.

Claim 5

In addition, claim 5(b) recites:

10/051,355
Art Unit 3692
9457.00

b) means for obtaining telephone number for a telephone associated with the user;

The Office Action has identified no such "telephone number" in the references.

The Office Action has identified no such "telephone associated with the user."

All claim recitations must be shown in the references.

The Office Action, page 6, asserts that the claimed "contact information" is shown in Savage, column 4, lines 15 - 18.

However, Appellant points out that claim 5 does not recite "contact information."

Further, that passage merely refers to an ATM which speaks to a customer. There is no "telephone associated with the user" which is contacted by Savage's ATM.

Claim 6

Claim 6 states that cash is dispensed by the ATM, when so instructed by the "communications device" via a "link." That is, the "transaction" is "entered" on the "communications device" "associated with an ATM customer," and reaches the ATM via the "link."

That is not found in the references.

The Office Action relies on Savage, column 4, lines 15 - 18 to show much of this recitation. However, as explained above,

10/051,355
Art Unit 3692
9457.00

that passage in Savage merely refers to an ATM which speaks to a customer. There is no "communications device" "associated with an ATM customer" which is contacted by Savage's ATM.

Claim 10

The discussion of claim 1 and 6 apply here.

In addition, claim 10 recites obtaining a "telephone number." That has not been shown in either reference.

Claim 10 states that the "cash dispenser" "dispense[s] cash" when the "entered ATM transaction" "require[s]" that. The "entered ATM transaction" is "entered" over a "telephone."

Neither reference shows that.

**ARGUMENT re:
REJECTION OF CLAIMS 2 AND 13
AS OBVIOUS UNDER 35 USC § 103,
BASED ON AHUJA, SAVAGE, AND OFFICIAL NOTICE**

Point 1

This current rejection defeats the previous rejections of claims 5 and 10. Those claims recite a "telephone number."

This current rejection admits that neither reference used to reject claims 5 and 10 show retrieving a telephone number.
(Office Action, page 8, lines 10, 11.)

10/051,355
Art Unit 3692
9457.00

Point 2

The rejection is illogical, and shows no expectation of success.

Claims 2 and 13 are dependent claims.

In the respective parent claims, the element to which the "telephone number" relates is a "communications device," such as a cell phone.

However, the rejection of the parent claims treated the claimed "communications device" as **TWO ATMs**:

- the portable ATM of Ahuja' (Office Action, page 5, lines 4, 5), and
- the talking/listening ATM of Savage (Office Action, page 5, end of fourth-from-last paragraph.)

There is no "telephone" at either of those ATMs.

Thus, the Officially Noticed "telephone number" has no relation to the references. There is nothing to call, using that "telephone number."

Point 3

In response to the invocation of "Official Notice," the undersigned attorney respectfully traverses the Official Notice, and requests a citation of evidence showing the Noticed element. (See MPEP § 2144.03.)

10/051,355
Art Unit 3692
9457.00

One reason is that the Noticed "telephone number" is that of a bank account holder in the prior art.

However, in the combined references (Ahuja and Savage), there is no telephone at which that bank account holder can be reached.

Thus, the Noticed "telephone number" appears irrelevant to the references.

Point 4

Official Notice is not a substitute for a teaching for combining the Noticed element with other references.

No teaching has been given for combining the Noticed element with the references. The Office Action merely concludes that it is "obvious" to add the Noticed element. (Office Action, page 8, paragraph beginning "Re. Claims 2 & 3 . . .", third sentence.

That conclusion is not a teaching.

Point 5

The Notice is incomplete.

The Office Action is actually Noticing **FOUR** elements, namely

- 1) telephone numbers present in bank records, and
- 2) making those bank records computer-accessible to an ATM, and

10/051,355
Art Unit 3692
9457.00

- 3) extracting the telephone numbers by an ATM, and
- 4) using the ATM to call a telephone, or other device.

The Notice, as invoked, plus the other references, do not show the claims. At least three of the elements listed above are missing from the Notice. Without those elements, the claimed call cannot be made.

**ARGUMENT re:
REJECTION OF CLAIM 7
AS OBVIOUS UNDER 35 USC § 103,
BASED ON AHUJA, SAVAGE, AND OFFICIAL NOTICE**

The discussion of claims 2 and 13 applies here, and is repeated by reference thereto.

**ARGUMENT re:
REJECTION OF CLAIMS 17 AND 20
AS OBVIOUS UNDER 35 USC § 103,
BASED ON AHUJA, SAVAGE, AND WALKER**

Point 1

Walker shows a system where, for example, a father gives a credit card to his son. However, a limit is placed on the card. If the son tries to exceed the limit, the credit card company telephones the father, to obtain authorization. (Summary of Invention and column 10, line 9 et seq.)

That simply does not show the claim recitation, which is the

10/051,355
Art Unit 3692
9457.00

following:

17. A method according to claim 16, and further comprising:

d) delivering an item of value, or media relating to the transaction, to a second person located at the ATM, who is different from the customer.

The reason that the claim is not shown is that the Office Action is asserting that

-- **IF** the son in Walker is withdrawing money at an ATM,

and

-- **IF** the son is exceeding his limit,

and

-- **IF** the father authorizes the transaction, then claim 17, apart from the parent claim, is shown.

However, MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

The Office Action relies on a **hypothetical scenario** involving Walker. Hypothetical scenarios are not prior art.

10/051,355
Art Unit 3692
9457.00

Point 2

The rationale for combining the references does not lead to the claimed invention.

The rationale is that Walker's authorization approach should be applied to a person at an ATM.

However, if you want to achieve that, you can simply assume that Walker's "son" is present at Savage's ATM.

You do not need the combination of three references to attain the goal of the rationale.

Thus, the Office Action's rationale does not lead, as a matter of logic, to the three combined references.

This applies to claim 20.

10/051,355
Art Unit 3692
9457.00

CONCLUSION

Applicant requests that Board overturn the rejections, and pass all claims to issue.

Respectfully submitted,



Gregory A. Weite
Reg. No. 30,434

NCR Corporation
1700 South Patterson Blvd.
WHQ - 3
Dayton, OH 45479
February 9, 2008
(937) 445 - 4956

ATTACHMENTS: -- CLAIMS APPENDIX,
 -- STATEMENT THAT NO EVIDENCE APPENDIX IS
 ATTACHED,
 and
 -- STATEMENT THAT NO RELATED PROCEEDINGS APPENDIX
 IS ATTACHED

10/051,355
Art Unit 3692
9457.00

8. CLAIMS APPENDIX

1. An Automated Teller Machine, ATM, comprising:

- a) a user interface including means for identifying a user;
- b) means for obtaining contact information which enables the ATM to contact a communications device associated with the user; and
- c) contact means for establishing a link with the communications device to allow a transaction to be executed using the communications device.

2. A terminal according to claim 1, wherein the means for obtaining contact information includes means for retrieving a telephone number of the communications device.

3. A terminal according to claim 1, wherein the contact means contacts the communications device directly.

4. A terminal according to claim 1, wherein the contact means requests a remote transceiver to establish a link with the communications device.

5. An Automated Teller Machine, ATM, comprising:

- a) a user interface including means for

10/051,355
Art Unit 3692
9457.00

identifying a user;

- b) means for obtaining telephone number for a telephone associated with the user; and
- c) contact means for establishing a link with the telephone to allow a transaction to be executed using the telephone.

6. An automated teller machine (ATM) comprising:

- a) a cash dispenser for dispensing cash;
- b) means for obtaining contact information which enables the ATM to contact a communications device associated with an ATM customer;
- c) means for establishing a link with the communications device based upon the obtained contact information to allow the ATM customer to enter an ATM transaction; and
- d) means for controlling the cash dispenser to dispense cash when the entered ATM transaction requires cash to be dispensed.

7. An ATM according to claim 6, wherein the means for obtaining contact information includes means for retrieving data relating to a telephone number to be called to establish a link with the communications device associated with the ATM customer.

10/051,355
Art Unit 3692
9457.00

8. An ATM according to claim 6, wherein the contact means includes means for directly contacting the communications device associated with the ATM customer.

9. An ATM according to claim 6, wherein the contact means includes means for requesting a remote transceiver to establish a link with the communications device associated with the ATM customer.

10. An automated teller machine (ATM) comprising:

a cash dispenser for dispensing cash;
means for obtaining a telephone number for a telephone associated with an ATM customer;
means for establishing a link with the telephone based upon the obtained telephone number to allow the ATM customer to enter an ATM transaction; and
means for controlling the cash dispenser to dispense cash when the entered ATM transaction requires cash to be dispensed.

11. A system of Automated Teller Machines, ATMs, comprising:

- a) a host;
- b) a group of ATMs, each having a user interface including transaction entry means

10/051,355
Art Unit 3692
9457.00

and means for identifying a user;
c) means for obtaining contact information which enables an ATM to contact a communications device associated with the identified user; and
d) contact means for contacting the communications device to allow a transaction to be executed using the communications device.

12. A method of operating an Automated Teller Machine, ATM, the method comprising the steps of:

(a) identifying a user;
(b) obtaining contact information which enables the ATM to contact a communications device associated with the identified user; and
(c) establishing a telecommunications link with the communications device so that a transaction may be executed via the link.

13. A method according to claim 12, wherein step (b) includes the step of:

(b-1) retrieving a telephone number to be called to establish a telecommunications link with the communications device.

10/051,355
Art Unit 3692
9457.00

14. A method according to claim 12, wherein step (c) includes the step of:

(c-1) directly establishing a telecommunications link with the communications device.

15. A method according to claim 12, wherein step (c) includes the step of:

(c-1) requesting a remote transceiver to establish a telecommunications link with the communications device.

16. A method of operating an automated teller machine (ATM), the method comprising the steps of:

(a) identifying an ATM customer desiring to carry out an ATM transaction;

(b) obtaining contact information which enables the ATM to contact a communications device associated with the identified ATM customer; and

(c) establishing a link with the communications device associated with the ATM customer to allow the ATM customer to enter the desired transaction.

10/051,355
Art Unit 3692
9457.00

17. A method according to claim 16, and further comprising:

d) delivering an item of value, or media relating to the transaction, to a second person located at the ATM, who is different from the customer.

18. A method according to claim 16, wherein step (c) includes the step of:

(c-1) directly establishing the link with the communications device associated with the ATM customer.

19. A method according to claim 16, wherein step (c) includes the step of:

(c-1) requesting a remote transceiver to establish the link with the communications device associated with the ATM customer.

20. Method according to claim 17, in which the identified person delivers a Personal Identification Number, PIN, to the ATM, and the second person does not.

10/051,355
Art Unit 3692
9457.00

9. EVIDENCE APPENDIX

None.

10/051,355
Art Unit 3692
9457.00

10. RELATED PROCEEDINGS APPENDIX

None.